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Attorney Docket IBM- 178

YO998-086 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Angelopoulos, et al.

Serial Number : 09/036,458

Filing Date : March 6, 1998

Examiner : T. Yoon

Group Art Unit : 1714

For : METHODS OF PROCESSING AND  
SYNTHESIZING ELECTRICALLY CONDUCTIVE  
POLYMERS AND PRECURSORS THEREOF TO  
FORM ELECTRICALLY CONDUCTIVE  
POLYMERS HAVING HIGH ELECTRICAL  
CONDUCTIVITY

BOARD OF PATENT  
APPEALS &  
INTERFERENCES  
OCT - 2 2003

Hon. Board of Patent Appeals and Interferences  
United States Patent and Trademark Office  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

Appellants respectfully petition this Honorable Board to take the following action with respect to the instant application on Appeal:

1. Remand this case to the Examiner in Group Art Unit 1714 so that prosecution on this application can commence *de novo*, and authorize the Examiner to issue a "first" Official Action commensurate in substantive scope to that which the Examiner details in his "*Examiner's Answer*" dated May 9, 2003; or in the alternative;

2. Strike all portions of the *Examiner's Answer* in its consideration of same on the merits, which portions exceed the scope of the content of the rejections that the Examiner issued in the Official Actions during the course of the prosecution of this case, and which rejections were never articulated in the course of the prosecution of this case until the Examiner's Answer was received.

# 1. REMAND THIS CASE TO THE EXAMINER

In their Appeal Brief to this Honorable Board, Applicants stated, inter alia, that the Examiner had not properly applied the references to Applicants' claims. Applicants will not restate the points that they made in their brief, but rather hereby incorporate by reference the arguments made in said brief. This Honorable Board is directed particularly to pages 4 through 9 of Appellants' brief wherein they point out, for example, at page 8 that:

*"...It is here that Applicants are stymied in their efforts to specify the errors in the rejection. They have pointed out that the relationship of concentration and electrical conductivity as recited in claim 1 provides unexpected results. The specific limitations of electrical conductivity as a function of concentration of electrically conductive polymer in fluorinated solution are present in the rejected claims. This is not described in the prior art. By virtue of not applying the references to the claims with any degree of specificity, Applicants cannot use the Examiner's basis for rejection to properly explain how the limitations they have inserted into the claims render the claimed subject matter unobvious over the prior art..." (Emphasis Added)*

A review of the Examiner's Answer makes abundantly clear that the Examiner has tacitly agreed with Appellants' position, as said answer is replete with the type of detailed rejections that should have been present (but were not) in the prosecution from the initial Official Action.\*

To respond properly to the Examiner's Answer at this stage would require that all of the cited references would have to be considered and argued for the first time in light of the rejection. The arguments to overcome the specific rejections would be for the first time in the Rebuttal Brief.

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\* As an example of how the Examiner has expanded the scope of his rejections in his Answer vis a vis the office action, compare the perfunctory rejection of "Claims 1 - 12 and 16 - 19 under 35 U.S.C. 102(b)...to...103(a)...over Jonas" found on page 5 of the Official Action dated February 26, 1999 with the detailed rejection found in the Examiner's Answer on pages 5 to 7.)

The support for this request is found in 37CFR 1.106 *Rejection of Claims*,

...*(b) In rejection claims for want of novelty or for obviousness, the examiner must cite the best references at his command. When a reference is complex or show or describes inventions other than that claimed by Applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified....*

## 2. STRIKE PORTIONS OF THE EXAMINER'S ANSWER

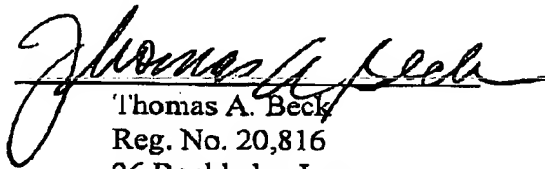
On the eve of the determination of this matter by this Honorable Board, the Examiner is for the first time explicating the basis for his rejections. MPEP §1208 *et seq.* requires the Examiner in his Answer, to point out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection. The Examiner appears to have attempted to do this in his Answer. The objection now raised by Applicants is that the Examiner should have done this explication during the course of the prosecution of this case so that Applicants could have had an opportunity to modify the claims in view of the teachings disclosed in the references. The position of the Examiner with respect to claim rejection is now on record for the first time.

According to 37 C.F.R. 1.193 (b) Applicants may direct their response to the Answer only to such new points of argument as are raised in the Examiner's Answer. This is tantamount to arguing the issues *de novo*. The MPEP (1208.03) states that considering an argument advanced for the first time in a reply brief would not only delay the proceeding, but would also entail the risk of an improvident or ill-advised opinion on the legal issues tendered. (Citing *VonBrimer v. Whirlpool Corp.*, 536 F2d 838, 846 (9<sup>th</sup> Cir. 1976)). This holding as a matter of equity and fairness should apply equally to the Examiner's Answer. Applicants respectfully submit that the same risk of an improvident or ill-advised opinion on the legal issues tendered will apply equally in this case if the Examiner is allowed to specifically apply the references to the pending claims for the first time in his Answer.

Those portions of the Examiner's Answer that were not contained in the prosecution history of this case should be excised from consideration by this Honorable Board for the reason stated above.

Dated: May 30, 2003

Respectfully submitted,

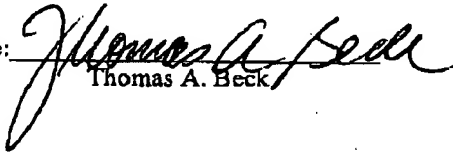


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I hereby certify that this paper is being deposited on the date indicated below with the U.S. Postal Service as First Class Mail addressed to Commissioner of Patents & Trademarks, Washington, D.C. 20231

Signature:

Name:



Date: May 30, 2003